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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,060	07/09/2001	Roger Collins	05545.P001	9276

7590

07/18/2003

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EXAMINER

WAMSLEY, PATRICK G

ART UNIT

PAPER NUMBER

2819

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/902,060

Applicant(s)
Collins et al

Examiner
Patrick Wamsley

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2819



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 12, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12 6) ☐ Other:

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DETAILED ACTION

Information Disclosure Statement

Receipt is acknowledged of IDS papers, filed on 01/14/2003.

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15 and 20-30 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,771,010 to Masenas, hereafter Masenas, cited as an "X" reference for these claims on an International Search Report mailed on 11/25/2002.

For claim 1, Masenas provides a method comprising the steps of identifying a data block within an electronic message; generating a pointer identifying the block [by means of a history buffer] from a previous electronic message; and replacing the data block with the pointer. Claim 11 restates these method elements in apparatus format.

For claim 21, Masenas also provides a method comprising the steps of providing an interface and replacing data blocks with pointers.

For claims 2, 12, and 23, Masenas transmits data to a device for storage.

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For claims 3, 13, and 24, Masenas decompresses a message by inserting data from a previous message [corresponding to a substitution code].

For claims 4, 14, and 25, Masenas identifies a previous message based on a subject field

For claims 5, 15, and 26, Masenas identifies if a message is in response to a previous message.

For claims 6 and 27, Masenas uses various compression techniques

For claims 7 and 28, Masenas replaces common strings of characters with codes.

For claims 8 and 29, Masenas defines one character string as an e-mail address domain.

For claims 9 and 30, Masenas uses six bits of code per character

For claims 10 and 22, Masenas compresses e-mail messages.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masenas in view of EP 909,037 to Ishida et al, hereafter Ishida, cited as a "Y" for these claims on an

International Search Report mailed on 11/25/2002.

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Unlike claim 16, Masenas does not clearly recite alternate compression modules. In contrast, Ishida discloses selection of multiple compression methods, such as run-length and Lempel Ziv [abstract, last three lines], thereby applying alternate compression modules. At the time of the invention, it would have been obvious to one of ordinary skill in the art to have applied Ishida's teachings to the system of Masenas. The motivation would have been to apply optimum compressing methods to different data blocks, as suggested by Ishida on lines 3-6 of page 3.

For claim 17, Masenas defines one character string as an e-mail address domain.

For claim 18, Masenas uses six bits of code per character.

For claim 19, Masenas compresses e-mail messages.

Response to Arguments

7. Applicant's arguments filed on 05/12/2003 have been fully considered but they are not persuasive.

First, applicant argues that Masenas does not disclose or suggest the compression of electronic messages. In response, Masenas is drawn to the art of communication between one computer system and other computer systems [col. 1, lines 20-22]. As Masenas describes the use of text files, such communication would inherently encompass e-mail, a means of transmitting text files between one computer and another.

Second, applicant argues that Masenas does not disclose generation of a pointer. In response, Masenas describes the use of a code token as a substitute for frequently used words in text files, such as the article "the." This token appears equivalent to the claimed pointer.

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Third, applicant argues that Masenas does identify a block of data in a previously received data string. In response, words such as "the" are very common, so it's unlikely that Masenas would only use a substitute block once. Therefore, a data block would inherently correspond to multiple data strings, received over a prolonged period of transmission.


Fourth, applicant alleges that Ishida lacks a pointer. In response, Masenas provides a pointer as described above. Ishida is relied upon for its teachings of compression modules.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE - MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,141,695 to Sekiguchi et al presents an e-mail system able to use pointers to symbolize pre-set data. U.S. Patent 6,222,909 to Qua et al discloses the use of key phrases or words as pointers to particular command sequences. U.S. Patents 6,081,780 and 6,246,672 to Lumelsky use allophone dictionaries to store voice segments and words.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick G. Wamsley whose telephone number is (703) 305-3504.


Patrick G. Wamsley
July 9, 2003